

REMARKS

The Office Action dated July 15, 2003, has been received and carefully considered. Claims 28-57 remain pending in the present application.

Applicants respectfully request consideration of claims 28-57 in view of the following remarks.

I. NEWLY ADDED CLAIMS 28-57

At paragraph 3 of the Office Action, the Examiner rejected claims 13-14 under 35 U.S.C. § 103(a) as being unpatentable over Keen et al. (U.S. 5,774,882). Further, at paragraph 5 of the Office Action, the Examiner rejected claims 13-17 and 19-27 as being unpatentable over Keen under 35 U.S.C. § 103(a). In response to the Examiner's rejections, and in an effort to clarify and further point out the novelty of the present invention, the Applicants have cancelled claims 13-17 and 19-27 and have added new claims 28-57.

Newly added claims 28-57 are clearly supported in applicant's original specification which provides in pertinent part:

Processing may be contingent on the outcome 404 of the read 402. A form code identifies the particular type of form. If the form code was successfully interpreted, then a priority may be assigned to the form 410. Assignment of priority may be based, for example, on a preferred client list, according to the profit margin that a seller of goods or services expects to receive from a buyer, or according to other criteria. The priority assigned in step 410 may be represented on a scale of 1 to 10, designated by high, medium, or low, or otherwise rank ordered. If the form code read was not successful in step 402, then the form may be routed to data repair 406 for manual classification of the incoming form type.

Page 9, lines 4-12.

II. THE NON-OBVIOUSNESS OF NEWLY ADDED CLAIMS 28-57

A. Basic Requirement for Prima Facie Case of Obviousness

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re*

Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

B. The Non-Obviousness of Claims 28-57 Over Keen et al. (U.S. 5,774,882)

As claimed, the Applicants' invention provides a new and useful method for allowing businesses to: 1) receive customer information from at least one customer; 2) store the customer information in electronic format; 3) analyze the customer information to determine the business value of the customer submitting the customer information; and 4) process the customer information based upon the determined business value of submitting customer. This invention has the central advantage of allowing businesses to focus their document processing resources on customers who represent the greatest business value.

The Applicants' invention as claimed contains several key aspects which are not taught or suggested in the prior art. Keen, as a specific example, specifically fails to

teach or suggest a system which: 1) determines the business value of a customer; and 2) processes a submitted application in accordance with this determined value.

Overall, the system provided by Keen does appear to be a very comprehensive and valuable system for detecting fraud. However, Keen's system is limited to detecting fraud and it fails to teach or suggest any method for processing an application based upon the potential business value of an applicant. To the contrary, Keen strictly discloses a security system which searches for potentially fraudulent applications based upon: 1) whether the applicant is a business or an individual (Figure 1, #80); 2) whether there is a discrepancy between the postmark and the mailing address of the application (Figure 1, #100); and 3) whether there are a number of requests from a single address (Figure 1, #150). In point of fact, Keen's system teaches away from the Applicant's invention and it treats all credit applications the same regardless of their potential business value.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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